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| 10/596,811 | 09/01/2006 | Takahito Yabe | 5856 | 1744 |
| 26/936 7590 07/24/2008 SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910 | | | | |
| EXAMINER | | | | |
| CHANG, VICTOR S | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1794 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,811

Applicant(s)

YABE ET AL.

Examiner

Victor S. Chang

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 6/6/2008 have been entered. The specification and Claim 1 have been amended. New claims 2 and 3 have been entered. Claims 1-3 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. [US 5460873], and evidenced by BE 721495 [Derwent abstract].

Ogawa's invention relates to a composite cover material for making an integrally foamed article. Figs. 1 and 2 shows that the cover material (wadding material) comprises a permeable fabric (10) bonded (laminated) to a thin layer of latex foam (15) of rubbers or synthetic resins. The latex foam has fine open cells (18) and permeable finer open cells (20) near its outer surface skin (22). The skin (22), though permeable by minute holes, serve as smooth barrier surface against liquid foamable mixtures poured directly onto said skin for making body foam (25) so as to prevent substantial impregnation of the foamable mixtures into said latex foam [abstract].

Examples 1-3 show that various latexes, such as urethane latex, etc., can be used to form the latex foam.

For claim 1, Ogawa is silent about 1) the foam layer of the cover material includes polyester, 2) the number of fine cells per inch. However, regarding 1), the examiner takes Official notice that forming a foam layer for a skin material with a polyester polyurethane is common and well known. In response to applicants' request to cite a reference in support of the Official notice, the examiner notes that BE '495 relates to a composite for covering cushions. One side of the composite is composed of a textile fabric, and the other side is a elastic polyester polyurethane latex foam layer [Derwent abstract]. It would be obvious to one skilled in the art to substitute Ogawa's latex foam with a polyester polyurethane foam, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding 2), since Ogawa teaches the general structure and composition features of claimed invention, and for the same end use as the claimed invention, a workable number of cells per inch is deemed to be an obvious routine optimization to one of ordinary skill in the art, motivated by the desire to obtain similar permeability control of the foamable raw material into the skin material.

For claim 2, since Ogawa teaches substantially the same structure and composition, and for the same end use as the claimed invention, a workable depth of impregnation is deemed to be an obvious routine optimization, motivated by the desire to obtain the beneficial effect of preventing substantial impregnation.

For claim 3, Ogawa teaches that the thickness of latex foam layer is 1-3 mm [col. 6, ll. 46].

Double Patenting

5. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/596810.

Although the conflicting claims are not identical, they are not patentably distinct from each other because obviously read on each other as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

6. Since the grounds of rejection over JP 2004-268406 are not maintained, applicants' arguments directed to JP '406 are moot.

Applicants argue at Remarks page 9 that

"Turning to Ogawa et al., that reference does not suggest a linear cell density within the range recited in claim 1. Actually, the only cell population densities mentioned are at the top of column 3: from 20,000 to 70,000 cells per cm^2 . That is well outside the presently claimed range of 80-90 per inch. In addition, Ogawa does not suggest air permeability within the range recited in claim 1."

However, Orgawa teaches at column 3, lines 11-21 that

"The number of cells can be varied on the average preferably from 20,000 cells per cm^2 to 70,000 cells per cm^2 . This adjusting can be easily carried out in the place where the cover materials are manufactured utilizing latex foam layers of the invention in contrast to the prior art slab urethane foam which is supplied as a finished product from another place. Further, the latex foam layer employed in the present invention has a distinct advantage in that the sizes of open cells in the latex foam layer are one fifth to one tenth as small as those of prior art slab urethane, and even from one tenth to one eightieth in the superficial skin."

Clearly, in contrast to the number of cells measured in thickness direction of the instant invention [see specification page 5, first full paragraph], Orgawa teaches that the number of cells is measured over an area, and the cell density changes through the thickness. These measurements are unrelated and there is no evidence Orgawa must have higher cell density per inch than the instantly claimed invention. The examiner maintains that since Orgawa expressly teaches that the sizes of the open cells are result effective in permeability, and Orgawa teaches a gradient of density through the thickness, a workable number of cells per inch through the thickness is deemed to be an obvious routine optimization to one of ordinary skill in the art.

Regarding the obvious-type double patenting rejection, applicants state that a terminal disclaimer with respect to copending application No. 10/596,810 has been submitted. However, the terminal disclaimer is absent from the amendment filed 6/6/2008.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794